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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,751	03/09/2001	Jean-Pierre Robin	017751-021	5968

7590

02/25/2002

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EXAMINER

GOLDBERG, JEROME D

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 02/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,751

Applicant(s)

ROBIN ET AL.

Examiner

Jerome D Goldberg

Art Unit

1614

-- Th MAILING DATE of this communication appears on th cov r sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 2, and 4-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____ .
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

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Applicants should provide copies of the 55 references refer to in the specification.

In view of Applicants' remarks in Paper No. 6, the restriction requirement of paper No. 4 is herein withdrawn and the following action is given.

Group I: Claim 1, 2, 4-7, 9-17, 19-21 and 24-27 are drawn to methods for treating cancer employing a herringboning compound wherein R_3 and R_4 may or may not form a heterocyclic groups which is classified in class 514, subclasses 211.09 or 211.10.

Group II: Claims 8, 18, 22 and 23 drawn to methods for treating cancer employing the Group I compound and a nucleoside which would be classified in class 514, subclass 43, 49, etc.

It is noted that the combination with a nucleoside is higher in the classification of class 514.

If Applicants elect Group I, they are further required to elect a specific herringboning since the compound is in two different subclasses.

If Applicants elect Group II, they are required to elect a specific herringboning and a specific nucleoside since both types are in different subclasses.

The several inventions above are independent and distinct, each from the other, as they have acquired a separate status in the art of treating cancer and leukemia as a separate subject matter for inventive effect and require independent searches. It is noted that a reference to one compound would not be a reference to another compound under 35 U.S.C. 103. Further, the claims read on a multitude of compounds and combinations which would require many field of searches that would be an undue burden on the Examiner. Therefore, restriction for examination purpose is proper.

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Applicants are required to make a provisional election even though this requirement is traversed.

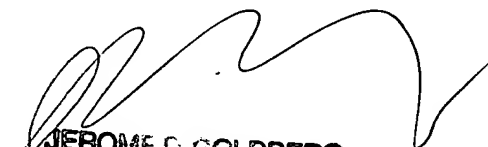
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Goldberg whose telephone number is 308-4606. The examiner can normally be reached on Monday to Thursday from 9 AM to 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins, can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Goldberg/LR

February 19, 2002



JEROME D. GOLDBERG
PRIMARY EXAMINER